

## REMARKS

In the Office Action dated November 29, 2005 ("OA"), the Examiner rejected claims 1, 3, 6-13, and 17 under 35 U.S.C. § 103(a) as unpatentable over May et al., "Reducing the Peak-to-Average Power Ratio In OFDM Radio Transmission Systems," ("May") in view of U.S. Patent No. 5,262,734 to Dent et al. ("Dent").

Applicants cancel claim 1 and rewrite claims 2, 6, and 8, which previously depended on claim 1, in independent form. Applicants change the dependency of claim 11. Applicants also cancel independent claim 12 and rewrite claims 14 and 17, which previously depended on claim 12, in independent form. Applicants also change the dependencies of claim 13.

Further, Applicants amend claims 4, 5, 15, 16, and 18-20 to restore them to their as-issued state.

No new matter is added in this Amendment, particularly because claims have either been canceled, rewritten in independent form, or had dependencies changed.

Claim 2 recites a combination of elements including, among other things:

a delay element coupled between said modulated-signal generator and said combining circuit to delay said first modulated signal into synchronism with said constrained bandwidth error signal.

In a co-pending Application No. 10/718,507, the inventor filed an "Inventor's Submission" on July 6, 2005. The Inventor's Submission stated:

Since the pulse-shape extends in both directions in time from the point at which its peak occurs, the teaching clearly requires that the input signal is delayed by at least half of the pulse-shape duration. In view of the foregoing, it is clear that May's

approach inherently uses a delay; in my opinion it cannot be done any other way. . . . May clearly teaches that the scaled bandlimited pulse-shape must be time aligned so that the pulse peak and the signal peak are time-coincident . . . .

*Id.* at 1-2 (underlining added and removed; citations omitted). Applicants, however, disagree with this and other opinions expressed in the Inventor's Submission. Even if May inherently disclosed "that the input signal is delayed by at least half of the pulse-shape duration," which it does not, May would not enable one of ordinary skill in the art to carry out the claimed invention. In fact, May does not disclose *how* to delay "the input signal." Further, May does not disclose *how* to time-align the scaled band-limited pulse-shape "so that the pulse peak and the signal peak are time-coincident." In fact, the alleged delay in May to make "the pulse peak and the signal peak . . . time-coincident" would be *variable*. See Affidavit of Dr. Neil Birch. Further, one of ordinary skill in the art would not be able to enable the delay in May (a *variable* delay) without undue experimentation. See Affidavit of Dr. Neil Birch.

At best, therefore, May can only be used as a reference under § 103 with respect to the "delay element," as recited in claim 2. See M.P.E.P. § 2121.01; *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled."); *see also Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991) (stating "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103."). The Examiner, however, has not alleged that the "delay element" recited in claim 2 is obvious in view of May or

*Dent*. Further, enabling the variable delay in *May* is beyond the skill of one of ordinary skill in the art. See Affidavit of Dr. Neil Birch.

On the other hand, one embodiment in the Applicants' specification enables "a delay element" by disclosing a fixed delay element. See Fig. 2, element 138 ("Delay Element"). Applicants' note, however, that claim 2 is not limited to a fixed delay.

Applicants also note that the Inventor's Submission is an un-sworn opinion and should not be relied upon by the Examiner. In fact, the inventor Ronald D. McCallister is not affiliated with the Assignee of this application. Further, from the Inventor's Submission, it appears as though Mr. McCallister is represented by counsel, but it is unclear who this counsel is and if he or she is a member of the patent bar.

For at least the above reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 2 under § 103(a).

Claims 3-5 and 11 depend on claim 2 and include all the limitations of claim 2. Thus, for the reasons set forth above, claim 3-5 and 11 are not obvious in view of *May* and *Dent*. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 3-5 and 11 under § 103(a).

Although claims 14 and 18 are of different scope from each other and claim 2, claims 14 and 18 recite features in common with claim 2. For example, claim 14 recites a combination of elements including, among other things, "delaying said first modulated signal." Further, claim 18 recites a combination of elements including, among other things, "a delay element for delaying said first modulated signal." Thus, claims 14 and 18 are allowable at least for the same reasons as claim 2. Applicants respectfully request

that the Examiner reconsider and withdraw the rejection of claims 14 and 18 under § 103(a).

Claims 13, 15, 16, 19, and 20 depend on one of claim 14 or claim 18 and include all the limitations of their respective base claims. Therefore, claims 13, 15, 16, 19, and 20 are allowable for at least the same reasons as claims 14 and 18. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 13, 15, 16, 19, and 20 under § 103(a).

Further, nowhere does the Examiner allege that either *May* or *Dent* disclose or suggest the elements of claims 2-10 or 13-17. Instead, the Examiner states, "Applicant representative admitted that May et al teaches every feature of the claimed invention." See Office Action at 3. Applicants respectfully disagree with the Examiner's characterization of Applicants' position. Applicants have stated "Prior art which would have rendered the broadest claims of the issued patent unpatentable was not considered." See, e.g., Reissue Application Declaration. Thus, Applicants have only referred to the "broadest claims," not all the claims. Applicants respectfully request that the Examiner indicate where in *May* or *Dent* the Examiner alleges the prior art teaches the features of claims 2-10 and 13-17. In addition, Applicants assert that independent claims 6, 8 and 17 and the claims that depend on them (claims 7, 9, and 10) are patentable in view of the prior art of record. Applicants, therefore, respectfully request that the Examiner reconsider and withdraw the rejection of claims under § 103(a).

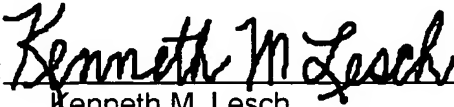
In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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